

United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO	
10/644,413	08/20/2003	Robert J. Mancuso	XXRM-18J	7925	
7590 06/27/2006		EXAMINER			
Iandiorio & Teska			BATTULA, PRADEEP CHOUDARY		
260 Bear Hill F	Road				
Waltham, MA	02451-1018	ART UNIT	PAPER NUMBER		
			3722		

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Applicat	ion No.	Applicant(s)					
Office Action Summary		10/644,4	113	MANCUSO, ROBERT J.					
		Examine	r	Art Unit					
			C. Battula	3722					
Period fo	The MAILING DATE of this communication or Reply	appears on th	e cover sheet with the c	orrespondence ad	idress				
WHIC - Exte after - If NC - Failu Any	ORTENED STATUTORY PERIOD FOR REICHEVER IS LONGER, FROM THE MAILING insions of time may be available under the provisions of 37 CFR SIX (6) MONTHS from the mailing date of this communication. of period for reply is specified above, the maximum statutory per re to reply within the set or extended period for reply will, by state reply received by the Office later than three months after the material part of	DATE OF T 1.1.136(a). In no e iod will apply and v litite, cause the ap	HIS COMMUNICATION vent, however, may a reply be timwill expire SIX (6) MONTHS from plication to become ABANDONE	N. nely filed the mailing date of this o D (35 U.S.C. § 133).	,				
Status				-					
1)⊠	Responsive to communication(s) filed on 20	August 200	3.						
2a)□	This action is FINAL . 2b) ☐ This action is non-final.								
3)	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is								
	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.								
Dispositi	on of Claims								
4)🖂	4) Claim(s) <u>1-8,21,22,24,33,34</u> is/are pending in the application.								
	4a) Of the above claim(s) is/are withdrawn from consideration.								
5)	Claim(s) is/are allowed.								
6)□	☐ Claim(s) is/are rejected.								
7)	Claim(s) is/are objected to.								
8)⊠	8) Claim(s) 1-8,21 22,24,33,34 are subject to restriction and/or election requirement.								
Applicati	on Papers								
9)	The specification is objected to by the Exam	iner.							
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.									
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).									
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).									
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.									
Priority ι	ınder 35 U.S.C. § 119								
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:									
	1. Certified copies of the priority documents have been received.								
	2. Certified copies of the priority documents have been received in Application No								
	3. Copies of the certified copies of the priority documents have been received in this National Stage								
* 5	application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received.								
222 m. a and a declared a mode declar for a not of the definied copies flot received.									
Attachma-	No.								
Attachment 1) ☐ Notic	t(s) e of References Cited (PTO-892)		4) Interview Summary	(PTO 442)					
2) 🔲 Notic	e of Draftsperson's Patent Drawing Review (PTO-948)		Paper No(s)/Mail Da	te					
3) Inform	nation Disclosure Statement(s) (PTO-1449 or PTO/SB/0 r No(s)/Mail Date	08)	5) Notice of Informal Pa	atent Application (PTC	D-152)				
i upe			o) □ Ouler						

Application/Control Number: 10/644,413 Page 2

Art Unit: 3722

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Claims 1- 8 and 44 and 34, drawn to a variable color print of an image, classified in class 283, subclass 114.
- II. Claims 21, 22, and 24, drawn to a method of producing a variable color print of an image, classified in class 101, subclass 483.
- 1. The inventions are distinct, each from the other because of the following reasons:
 - a. Inventions I and II are related as product made and process of making.
 The inventions are distinct if either or both of the following can be shown:
 (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case that the product as claimed can be made by another and

materially different process such as seen in U.S. Patent 4,932,685 where

the method has debossing and excludes ink mounds.

i. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper. Application/Control Number: 10/644,413

Art Unit: 3722

A telephone call was made to Attorney Kirk Teska, responded by Attorney
 Thomas Thompkins, on June 19, 2006, to request an oral election to the above restriction requirement, but did not result in an election being made.

a. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

Page 3

- b. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.
- c. Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.
- 3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pradeep C. Battula whose telephone number is

Application/Control Number: 10/644,413 Page 4

Art Unit: 3722

571-272-2142. The examiner can normally be reached on Monday - Friday 7:00AM - 3:30PM.

- a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
 - i. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.
 Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.
 For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pradeep Battula Patent Examiner June 19, 2006

MONICA CARTER
SUPERVISORY PATENT EXAMINER
